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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,950	11/08/2006	Roger William Frank Ashton	10557/323978	1482
30550	7590	05/21/2009		
DIANA HOUSTON SMITH & NEPHEW, INC. 1450 BROOKS ROAD MEMPHIS, TN 38116				
EXAMINER				
SWEET, THOMAS				
ART UNIT		PAPER NUMBER		
3774				
MAIL DATE		DELIVERY MODE		
05/21/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/559,950

**Applicant(s)**

ASHTON ET AL.

**Examiner**

Thomas J. Sweet

**Art Unit**

3774

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-14, 16-25 and 31-37 is/are pending in the application.
- 4a) Of the above claim(s) 12, 17-19 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-11, 13, 14, 16, 20-25 and 32-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 02/11/2009.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/17/2008 has been entered.

### ***Election/Restrictions***

Applicant's election without traverse of species A figs. 1-5, claims 1, 3-11, 13-14, 16, 20-25 and 32-37 in the reply filed on 02/12/2009 is acknowledged. Claims 12, 17-19 and 31 are withdrawn

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-11, 13-14, 16, 20-25 and 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tornier (US 6454809) in view of Garnett (US 3787132). Tornier discloses a fixing assembly (fig. 10) for securing a fixing member (29) to a prosthetic component (2, cup), the fixing assembly comprising: the prosthetic component (2) having either one of a female location feature (14) or a male location feature:

a fixing member (29) having the other of the wherein (a) the surface comprises a female location feature and the male location feature (37, dovetail), the male and female location features fitting together in use; and

a screw (at 40) that passes through an aperture extending through (40) the fixing member to secure the fixing member to the prosthetic component (once implanted the screw bids 37 in 14), the screw oriented in the aperture of the fixing member to secure purchase of the screw to a bone in which the prosthetic component is implanted. However, Tornier does not disclose disposition of the screw in the fixing member causes securing of the fixing member to the prosthetic component to occur whether or not the screw gains purchase in the bone. Garnett discloses another dovetail connecting member which disposition of the screw (28) in the fixing member causes securing of the fixing member (dovetail, 15b) to the base component (10) for the purpose of securing the dovetail to the base. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the dovetail and screw hole of Tornier to have a slit 20 passed the screw hole as taught by Garnett in order to independently secure the dovetail to the base (cup).

Regarding claim 3, The fixing screw is external to the prosthetic component (as modified).

Regarding claims 4-6, the male and female location features have at least one corresponding undercut to form an interference fit in use (i.e. dovetails).

Regarding claim 7, wherein the male location feature comprises at least one portion that is conical in profile (dovetails have a conical profile).

Regarding claim 8, wherein the male location feature has a slit, such that the male location feature is divided into two arms as modified.

Regarding claims 10 and 11, wherein the slit extends radially from the aperture of the fixing member and the slit is formed in a plane substantially parallel to the axis of the aperture (as modified).

Regarding claim 13, wherein the male location feature is a resiliently deformable material (20 is a relief for resilient deformation).

Regarding claim 14, the location feature of the prosthetic component is at least partly located on a rim of the prosthetic component (See fig. 10).

Regarding claim 16, wherein the fixing screw has a thickened portion that pushes apart the two arms of the male location feature when the fixing screw is screwed into the aperture of the fixing member (Garnett has element 27).

Regarding claims 20-21 and 25, wherein the prosthetic component is an acetabular cup (2).

Regarding claim 22, wherein the fixing member is secured to an external surface of the prosthetic component (at 14).

Regarding claims 32 and 37, wherein the female location feature is located on the prosthetic (14) component and the male location feature is located on the fixing member (37).

Regarding claims 33 and 34-36, the screw is threadably received in the aperture of the fixing member (member 27 of Garnett is threaded and in the aperture) causes the fixing member to be secured to the prosthetic component (as modified).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Sweet whose telephone number is 571-272-4761. The examiner can normally be reached on 6:45am - 5:15pm, Tu-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas J Sweet/  
Primary Examiner, Art Unit 3774